



PATENT
CASE NAME/No.: SP01-042

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: CHIEN, CHING-KEE et al.

Serial No: 10/077166

Art Group Unit: 2879

Filing Date: 2/15/2002

Examiner: Krishnan, Sumati

Title: OPTICAL FIBER COATING /
COMPOSITIONS

RESPONSE

Commissioner for Patents
Alexandria, VA 22313-1450

RESPONSE TO EXAMINER'S RESTRICTION REQUIREMENT

In the Office Action dated June 2, 2004, designated as Paper No. 20040528 in the above-captioned application, the Examiner issued a Restriction Requirement identifying the following groups of claims as being drawn to potentially distinct inventions:

- Group I. Claims 1 – 64, 67-93, and 96-101, drawn to optical fiber coating composition, classified in class 385, subclass 128; and
- Group II. Claims 65, 66, 94, and 95, drawn to method of making optical fiber, classified in class 427, subclass 161.3.

The Examiner asserted that these inventions may be regarded as independent and distinct from one another because the product as claimed can be made by another and materially different process such as coating the fiber with the coating composition and then sintering the perform to draw the fiber.

Applicants respectfully traverse the Examiner's Restriction Requirement on the grounds that the proposed inventions are not independent and distinct from one another, and that the proposed inventions are inextricably intertwined, and prosecution of the proposed groups of claims together would be most effective for the Office. In order to conduct a comprehensive search regarding any one of the groups, including the group provisionally elected above, it would be inherently necessary to review the same pertinent fields and classes of prior art relating to the other groups. Moreover, the important questions of patentability and claim interpretation are likely to be based on substantially similar issues and evaluations

for each group of claims, and would require consideration of the same prior art, and combined prosecution is therefore less likely to result in inconsistent or conflicting file histories.

As such, Applicant respectfully requests that the Examiner withdraw the Restriction Requirement in the next subsequent Office Action, and continue prosecution of Groups I-II, claims 1 - 101 together with one another. However, in the event the Examiner does not withdraw the Restriction Requirement, applicants elect Group I (1 - 64, 67-93, and 96-101) for examination, with traverse.

Applicants believe that no extension of time is necessary to make this Response timely. Should Applicants be in error, Applicants respectfully request the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Robert L. Carlson at 607-974-3502.

Respectfully submitted,

CORNING INCORPORATED

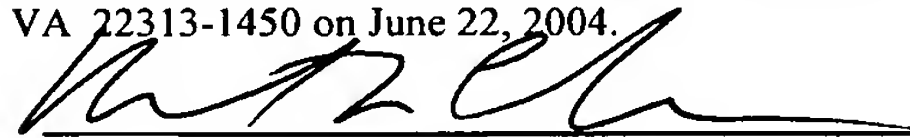


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Date: June 22, 2004

CERTIFICATE OF MAILING UNDER 37 C.F.R.

§ 1.8: I hereby certify that this paper and any papers referred to herein are being deposited with the U.S. Postal Service, as first class mail, postage prepaid, addressed to Commissioner of Patents, Alexandria, VA 22313-1450 on June 22, 2004.



Robert L. Carlson